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| EXAMINER |
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GILBERT, WILLIAM V

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| ART UNIT | PAPER NUMBER |
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3635

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10/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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| Office Action Summary | Application No. 10/768,742 | Applicant(s) FUHR, JOHN CHRISTOPHER | |
| | Examiner William V. Gilbert | Art Unit 3635 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This is a Final Office Action. Applicant cancelled Claim 27.

Claims 1-26 remain pending.

Claim Objections

1. **Claim 1** is objected to because of the following informalities: Applicant has two "an outer perimeter" (lines 2 and 3). The Examiner suggests amending to "a first outer perimeter" and "a second outer perimeter" respectively. Appropriate correction is required.

Claim 14 is objected to because of the following informalities: lack of antecedent basis "the space", line 7. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-4, 7, 8 and 11-19 are rejected under 35

U.S.C. 102(b) as being anticipated by Thompson (U.S. Patent No. 3,875,712).

Claim 1: Thompson discloses an apparatus having a first frame member (Figure 2, element 28) having an outer perimeter (this is an inherent feature as the member is a channel section and virtually any perimeter is an outer perimeter), a second frame member (15) having an outer perimeter (inherent), the first member having a spacing element (Figure 4, element 25) the spacing element abuts an outer perimeter of the first member, and a flashing element (52) associated with the first member and a portion of the element is beyond the outer perimeter (in the direction toward what would be the ground) of the first frame member.

Claim 2: the spacing element (25) is a lip.

Claim 3: the spacing element includes a connector (41).

Claim 4: the lip (25) is positioned so that the first surface (Figure 4, 25) and second surface (15) are coplanar.

Claim 7: a fastener (used by holes 52a and 18a).

Claim 8: the spacing element (25) is attached to a wall (Figure 1 where 13 is connected to wall of trailer) and adapted to hold a plurality of joists (Figure 1, element 25).

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Claim 11: a plurality of spaced ledges (Figure 4, elements 41, side opposite end of 41) which correspond to the spacing between the plurality of joists.

Claim 12: a flashing element (Figure 2, element 52) attached to an edge of a framing member most distant from the spacing element.

Claim 13: the flashing element is integral with the first frame member at an edge most distant from the spacing element.

Claim 14: Thompson discloses a ledger with a first edge (Figure 4, element 33), a second edge (31) and a spacing element (36) associated with the first edge the spacing element abuts the first edge, and a flashing element (52) associated with the second edge, and positioned outside the space between the first edge and second edge.

Claim 15: the flashing element (52) associated with the second edge (31) and is perpendicular to the first edge and second edge (the flashing element extends to what would be to the ground which would make it perpendicular to the first and second edges.

Claim 16: the phrase "adapted for...edifice," lines 1 and 2, is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

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invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 17: the spacing element (36) has a built in pocket (33,36,43). The phrase "adapted to receive a joist," line 2, is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 18: the spacing element (36) includes a support surface (portion 36a proximate 33) between first and second edges of a joist (22 and 18), and the support surface is parallel to the first and second edges.

Claim 19: the spacing element (36) includes a support surface (41) coplanar with the first edge (22) of the joist.

Claims 1, 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Zamerovsky (U.S. Patent No. 5,533,310).

Claim 1: Zamerovsky discloses an apparatus having a first frame member (Figure 2, element 24a) having an outer perimeter (an inherent feature, see rejection of Claim 1 under Thompson, above), a second frame member (22b) having an outer perimeter and a spacing element (31) on the first member the spacing

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element abuts an outer perimeter of the first frame member, a flashing element (portions 85, 86) associated with the second member and a portion of the flashing element is beyond the outer perimeter of the second frame member (as it extends to the "ground" it extends beyond the frame member.)

Claim 8: the frame member is attached to a wall (Column 3, lines 5-10). The phrase "adapted to hold a plurality of joists" line 3, is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 10: the joists (26) are made of wood.

Claims 20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Daniels (U.S. Patent No. 4,313,688).

Claim 20: Daniels discloses a method for supporting a deck comprising placing a non-wood element (Figure 1, element 21) below an existing wood ledger (22) and attaching the non-wood element (21) to the wood ledger and structural component (second board parallel and attached to 22) that the existing wood element was attached.

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Claim 22: the non-wood element (21) has an extended lip (Figure 8, element 35) that supports the wood ledger (22) and portion of joist (second board parallel and attached to 22).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Horn (U.S. Patent No. 3,875,707).

Claim 5: Thompson discloses the claimed invention except for an adhesive that attaches the first and second frame members. Horn discloses a metal frame for a deck (Figure 3) where the metal pieces are adhered by welding (e.g. Column 3, lines 24-26). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use welding to adhere the first and second members in Thompson in order to strengthen the connection between the frame

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members as it is well known in the art that a weld produces a bond that is stronger than the metals that are bonded.

Claim 6: Thompson discloses a fastener (used in conjunction with 52a) to fasten the first and second frame members.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson in view of Parisien (U.S. Patent No. 5,483,773).

Claim 9: Thompson discloses the claimed invention including that the frame is metal, but does not disclose that the frame is aluminum. Parisien discloses a frame made of aluminum (Abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the metal frame in Thompson of aluminum because of its density properties and it is well known in the art to use aluminum in building frames.

Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniels in view of Parisien (U.S. Patent No. 5,483,773).

Claim 21: Daniels discloses the claimed invention except that the non-wood element (24) is made of aluminum. Parisien discloses a frame made of aluminum (Abstract). It would have

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been obvious at the time the invention was made to a person having ordinary skill in the art to make the non-wood element in Daniels of aluminum because of its density properties and it is well known in the art to use aluminum in such elements.

Claim 23: Daniels discloses placing a sleeve (21) over an existing post (23) associated with a deck, but does not disclose the sleeve is made of aluminum. Parisien discloses a frame made of aluminum (Abstract). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make sleeve in Daniels of aluminum because of its density properties and it is well known in the art to use aluminum in such elements.

Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniels.

Claim 24: Daniels discloses the claimed invention including a wood post (23) and a non-wood post (24). Daniels does not disclose replacing an existing post with a non-wood post. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to replace the wood post in Daniels with the non-wood post because non-wood posts typically have a longer life span than wood posts and are not subject to rot over time.

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Claim 25: the non-wood post (24) includes a post and sleeve (21).

Claim 26: the non-wood post includes a flange (Figure 10 element 38).

Response to Arguments

4. The following addresses Applicant's response dated 26 July 2007.

Applicant's amendments in response to the Claim Objection to Claims 8, 10 and 18 overcome the objection and it is withdrawn.

Applicant's amendment in response to the 25 U.S.C. § 112 rejection of Claim 15 overcomes the rejection and it is withdrawn.

Applicant's arguments filed 26 July 2007 have been fully considered but they are not persuasive.

Applicant's amendment to the claim to incorporate "an outer perimeter" (Remarks: page 7) does not claim around the prior art of record because as amended. Virtually any perimeter of the ledger member in the Thompson reference (cited above) is an

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outer perimeter as the ledger is claimed as an individual member.

Further, the examiner respectfully disagrees with Applicant's note regarding the flashing element of the Thompson reference. The Examiner contends that element 52, under broadest reasonable interpretation, is a flashing element, and it extends beyond the outer perimeter of the frame member (see rejection above.)

The Examiner respectfully disagrees with Applicant's argument of the rejection of Claim 14 (Remarks: page 8). The Applicant claimed only a first edge, a second edge, and a spacing element, however, provided virtually no further structural limitation associated with these limitations. As claimed, the Thompson reference still reads on the Claim. Regarding the flashing element (Remarks: page 8) see argument above.

The Examiner respectfully disagrees with Applicant's argument addressing the rejection of Claims 1, 8 and 10 (Remarks: page 9) using Zamerovsky (cited above). See rejection above regarding the "outer perimeter" limitation of claims. The Examiner agrees with Applicant regarding element 31 as the spacing element as the limitations of the claim provide no limitation as to what a "spacing element" is. The Examiner

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interpreted the flooring (31) as a spacing element as it spaces the first and second members at ninety degrees from each other. Regarding the flashing element (page 9) see rejection above).

The Examiner respectfully disagrees with Applicant's argument addressing the rejection of Claims 20 and 22 under Daniels (cited above). A ledger is defined as a horizontal [member] secured to the uprights of scaffolding [or posts, etc]. See *Merriam-Webster's Collegiate Dictionary*, tenth edition 1999. As a result the prior art of record reads on the claim. As a result, the arguments addressing the rejection of Claims 21 and 23-26 (Remarks: page 13) are not persuasive. Further, The Examiner was not taking official notice of the rejections of Claims 24-26, but merely rejected the claims by themselves as an obvious method of replacement to one of ordinary skill in the art.

The Examiner respectfully disagrees with Applicant's arguments of Claims 5 and 6 under Thompson (Remarks: page 11) as the argument of Claim 1 is not persuasive. Further, the Examiner still contends that a weld is a form of adhering in the broadest reasonable interpretation.

The argument regarding Claim 9 (Remarks: page 12) is not persuasive as the argument addressing Claim 1 is not persuasive.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be

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reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WVG 18 Oct 07

Basil K. Kato
USILK KATO
Primary Examiner
AU 3635 10/10/07